

REMARKS

As a preliminary matter, Applicants thank the Examiner for pointing out that claims 23-27 and 29-52 were inadvertently listed in Amendment C, filed March 5, 2004, as “Withdrawn” instead of “Cancelled,” which is the correct status of these claims.

As a second preliminary matter, Applicants acknowledges the Examiner’s request for another copy of the Information Disclosure Statement (“IDS”) that was filed on December 4, 2001, and the Examiner’s implicit acknowledgment that the Patent Office has misplaced the copies of the cited references that were included with this IDS. Accordingly, Applicants have enclosed herein courtesy copies of the originally filed IDS, the cited references, and return postcard acknowledging receipt of all of these papers by the Patent Office. Applicants submit that, because all of these papers were both timely filed and received by the Patent Office, no new papers or fees need to be submitted for the Examiner to give these documents proper consideration, and as according to the date they were filed. Applicants respectfully request acknowledgment of such consideration in the form of an initialed Form PTO-1449.

Claims 1, 3-5, and 7 stand rejected under 35 U.S.C. 102(b) as being anticipated by Sekiguchi et al. (U.S. 4,978,890). Applicants respectfully traverse this rejection for the reasons of record, and as follows. The cited reference does not disclose (or suggest) that a heat conduction member is adhered to at least one of a discharge tube and a reflector, or in a bonding state equal to or stronger than a hydrogen bond, as in claim 1 of the present invention.

Applicants and maintain and incorporate by reference herein those arguments previously advanced on pages 16-21 of Amendment C. Applicants respectfully request that the Examiner reconsider those arguments and withdraw this Section 102 rejection. Specifically, Applicants submit that the Examiner's definition of the term "adhere" as meaning simply "stuck to" fails to rebut any of the previous arguments made by Applicant in Amendment C.

Despite the Examiner's assertion to the contrary, nothing in Fig. 2 of Sekiguchi, or its accompanying description, teaches or suggests that the heat-conducting compound 70 is actually adhered to, or stuck to, the fluorescent lamp 10. Fig. 2 of Sekiguchi is a schematic diagram only, and not a scale layout of Sekiguchi's device. The schematic drawing merely shows that the compound 70 is *next to* the lamp 10, and the accompanying description only teaches that heat is conducted from the compound to the lamp. The Examiner has cited to nothing in the reference itself to support the Examiner's own personal assertion that the compound 70 can stick to the lamp 10 without any external force holding them together. The Examiner's own personal assurances that this claimed feature of the present invention must exist within the reference are irrelevant where the reference neither teaches nor suggests such features. Accordingly, for at least these reasons, the Section 102 rejection is respectfully traversed, and should be withdrawn.

Nevertheless, although Applicants do not agree that the Examiner has established a proper *prima facie* case of anticipation against claim 1 of the present invention, in the interests of expediting prosecution, Applicant's have amended claim 1 to more clearly

recite that the adherence of the heat conduction member of the present invention is a bonding state equal to or stronger than a hydrogen bond. Additionally, because claim 1 of the present invention previously recited such features, Applicants submit that no new issues requiring further search or consideration have been presented by this amendment. Accordingly, should the Examiner be of the opinion that a further search is necessary, the Examiner should submit any potential new grounds for rejection of claims in a subsequent nonfinal Office Action. All of the presently recited features of claim 1 should have already been given full consideration by the Examiner.

Claims 1-22 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi. With respect to these claims, Applicants submit that the Examiner's response should be vacated as being nonresponsive. This rejection was fully traversed in Amendment C, and the Examiner appears to be attempting to avoid answering Applicant's meritorious arguments by merely changing the grounds for the rejection from Section 102 to Section 103. However, because Applicants' previous arguments were directed to addressing either a Section 102 *or* a Section 103 rejection, and because Sekiguchi still remains the only cited reference against these claims, the repeated rejection of these claims based on Sekiguchi alone is nonresponsive, and should be withdrawn.

Specifically, the Examiner appears to imply that there is a lesser burden under Section 103 than under Section 102 for the Examiner to demonstrate where in the prior art each and every limitation of the present invention is taught or suggested. Just the opposite, however, is true. Section 2143.03 of the MPEP specifically requires the Examiner establish

where in the prior art each and every limitation and feature of the present invention is taught or suggested, in order to establish a *prima facie* case of obviousness under Section 103. In the present case though, the Examiner has failed to meet this burden. This deficiency in the stated rejection is even more apparent in light of the fact that the Examiner even acknowledges that the sole cited reference, Sekiguchi, fails to teach or suggest the features of the present invention at issue. Accordingly, for at least these reasons therefore, the Section 103 rejection of the present invention is respectfully traversed, and should be withdrawn.

Furthermore, the Examiner's assertions of inherency, directed toward the liquid form of mercury, fail to overcome the deficiencies in the sole prior art reference of record cited against these claims. Nowhere does the Sekiguchi reference itself teach or suggest the collection of liquid mercury at a specific position in the disclosed device. To establish a proper case of inherency, the Examiner was required to show how such specific features are inherent to *Sekiguchi's disclosure*. The Examiner has not done so. As previously argued, Sekiguchi fails to teach or suggest gaseous and/or liquid mercury at all. Therefore, there could be no *inherent* feature within Sekiguchi's disclosure that liquid mercury is collected at a specific point within Sekiguchi's device, and apart from gaseous mercury. Accordingly, the Examiner's assertion of inherency fails, and the Section 103 rejection must be withdrawn for these reasons as well.

In the event that the Examiner mistakenly meant to assert Official Notice, instead of inherency, for the personal assertions regarding gaseous and liquid mercury as used in this field of art, the Section 103 rejection would still be deficient as established.

Section 2144.03(A) of the MPEP requires that Official Notice may only be taken “where the facts asserted [are] well known, or to be common knowledge in the art...capable of instant and unquestionable demonstration as being well known.” In the present case, however, the Examiner has in no way established how the very broad conclusory assertion regarding liquid mercury can apply to all of the specifically recited features of the claims in question.

Independent claims 10, 22, and 28 do not recite mercury turning to liquid form “in a cold spot,” as asserted by the Examiner. These claims instead specifically recite liquid and gaseous mercury together in a discharge tube, and that liquid mercury is collected at a specific location within the tube. Even if Official Notice by the Examiner were appropriate therefore, such Official Notice would still fail to cover all of these claimed features and limitations of the present invention. For these additional reasons, the Section 103 rejection should also be withdrawn.

Reliance upon either Official Notice or inherency in the outstanding Office Action is still inappropriate, however, because Applicants have already traversed all such assertions by the Examiner in Amendment C. Specifically, Applicants have already argued that at least these specific features of independent claims 10, 12, and 28 were not taught, or suggested, by Sekiguchi. The Examiner’s “new” grounds for rejection have therefore already been fully addressed by Applicants. The Examiner though, has not answered any of these meritorious arguments.

Moreover, Section 2144.03(C) of the MPEP also requires that the Examiner must provide objective evidence, to support the Examiner’s own personal assertions of what

is obvious, in the next Office Action if a rejection is to be maintained. See also In re Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Because the Examiner has not provided any objective evidence to support the overly broad assertions for all of the claimed features and limitations of the present invention, the Section 103 rejection must be withdrawn for these reasons as well.

With respect to claim 10 specifically, although Applicants maintain that the outstanding rejection is inappropriate against the claim in its previous form, Applicants have grammatically amended claim 10 in the interests of expediting prosecution. Specifically, claim 10 has been amended to clarify that the feature of having the liquid mercury collected away from an end of the discharge tube means away from either of the opposite ends of the discharge tube. This definition should have been obvious from the plain language of the claim, as well as the disclosure in the Specification, but now more clearly reflects at least one of the embodiments disclosed.

Claim 17 has also been amended for grammatical clarity. Applicants submit that no new matter has been added by this amendment, and that the amended language is supported by the Specification to the present Application.

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of “Loda et al.” Applicants assume that the Examiner here refers to U.S. Patent No. 4,409,511 to Loda, as previously cited in the prior Office Action (Paper No. 12). Applicants therefore respectfully traverse this rejection for at least the reasons of record, and

those discussed above. Claim 6 depends from independent claim 1, and therefore includes all of the features of the respective base claim, plus additional features.

Applicants further traverse the rejection of claim 6 because the Examiner has failed to respond to any of Applicants previous arguments directed toward the inapplicability of combining Sekiguchi with Loda. The Examiner has so far provided no rationale to support this proposed combination, and has completely failed to respond to Applicants' specific arguments that the two technologies represented by the two respective references cannot be simply combined as proposed by the Examiner. Accordingly, the Examiner's repeated rejection of claim 6 is nonresponsive, and must be withdrawn.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (U.S. 3,777,199) in view of Sekiguchi. Applicants respectfully traverse this rejection for at least the reasons of record, and as follows. The Davis reference teaches away from the present invention, and the Examiner has failed to respond to any of Applicants' arguments directed toward the Davis reference.

As previously argued, Davis' housing member 30 is not a reflector, as still asserted by the Examiner (page 5 of Paper No. 043004), but instead a light transmissive material. Accordingly, Davis here specifically teaches away from claim 8 of the present invention, which specifically recites, among other things, a reflector covering the discharge tubes for reflecting light radiated from the tubes. Any prior art reference which teaches away from the claimed invention cannot form the basis for rejection of the claimed invention under

Section 103. Accordingly, for at least these reasons, the Section 103 rejection based in part on Davis is respectfully traversed.

The Examiner's new addition of Sekiguchi with Davis fails to overcome the deficiencies of the Davis reference by itself. The Examiner has merely asserted that Sekiguchi discloses a reflector, but does not explain how either Davis or Sekiguchi teaches or suggests a *motivation to combine* one reference with the other. Without such a clear teaching or suggestion within the prior art itself, the Section 103 combination of these two references fails to establish a *prima facie* of obviousness against claim 8, and therefore must be withdrawn. It is not enough for the Examiner merely to point out in various references where may be found certain features and limitations of the claimed invention. The Examiner is also specifically required to show where in the prior art is taught or suggested the motivation for combining the various features. See In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). Such motivation for the combination is to be treated by the Examiner as an additional feature of the present invention for which the Examiner must find clear support within the cited prior art. Because the Examiner has not done so with respect to claim 8, the Section 103 rejection of claim 8 must also be withdrawn for at least these reasons.

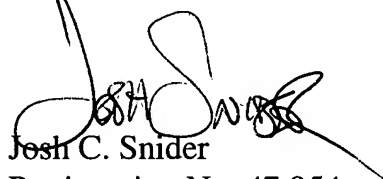
New claim 53 has been added to recite yet another combination of features of the present invention. Applicants submit that no new matter has been added by this claim. Entry, consideration on the merits, and allowance of new claim 53 are all respectfully requested.

For all of the foregoing reasons, Applicants submit that this Application, including claims 1-8, 10-22, 28, and 53, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By


Josh C. Snider
Registration No. 47,954

Customer No. 24978

August 4, 2004

300 South Wacker Drive
Suite 2500
Chicago, Illinois 60606
Tel: (312) 360-0080
Fax: (312) 360-9315
P:\DOCS\2803\66027\629132.DOC